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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,664	02/11/2002	Lorin C. Nash	19789-10	4604

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EASTMAN KODAK COMPANY
PATENT LEGAL STAFF
343 STATE STREET
ROCHESTER,, NY 14650-2201

EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,664

Applicant(s)

NASH ET AL.

Examiner

Hoa V. Le

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-- Th MAILING DATE of this communication appears on th cover sh et with the corr spondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-17, 22-36, 39-53 and 55-62 is/are pending in the application.
- 4a) Of the above claim(s) 17, 22-36, 39-53 and 55-62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-16 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1, 5-17, 22-36, 39-53 and 55-62 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

This is in response to the Papers filed on 14 August 2003.

I. The record shows that (1) the second compound with respect to “surfactant” in the canceled claim 2 and now in the amended claim 1 is considered as optional or obvious to one having ordinary skill in the art for using them either one alone or their combination as clearly pointed out and set forth in the Office action mailed on 27 March 2003. As agreed and elected on 05 May 2003. (2) “Applicants’ election of the species on the record has been considered and searched. The consideration and search are extended to the applied species in the applied references. Other non-elected species have not been considered, searched or examined until all of the elected and applied species are overcome” as clearly pointed out and set forth in the Office action mailed on 12 May 2003.

II. OLD “(1) It is allowed to claim by a functional, characteristic, physical and/or chemical property of a material and /or process (In re Swinehart, 169 USPQ 226). (2) However, a claimed functional, characteristic, physical and/or chemical property of a material and/or process carries with a risk (In re Swinehart, 169 USPQ 228). Therefore, one should be carefully looked into it for his own benefit. Please also see In re Schreiber, 44 USPQ2d 1432 since it is reasonable that the Office is not supplied, provided or equipped with a sufficient facility to carry out a test for the functional, characteristic, physical and/or chemical properties as claimed in accordance with the authority stated in In re Best, 195 USPQ 430; Ex parte Maizel, 27 USPQ2d 1662 or Ex parte Phillip, 28 USPQ2d 1302. The language “developing agent”, “surfactant”, “thickener”, surface

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tension...30 dynes/cm”, “viscosity...30,000 cP”, “buffered solution...pH...about 8”, “activator”, “restrainer”, “preservative”, “antifoggant”, “accelerator”, “non-Newtonian fluid” or the like is considered as the functional, characteristic, chemical and physical property of a material.”

OLD “(2) Within the authority of the Office being granted by the authority in the court of law, applicant is required to show or provide an evidence to the contrary to the applied material and process from the applied reference for the claimed property of the material and process as claimed for its patentability in accordance with the authority stated in In re Swinehart, 169 USPQ 228. It is should be noted that an argument alone (1) would be taken a place of an objective evidence as a matter of law (2) has and (3) is given a little to no value.”

NEW (3) In re Schreiber, 44 USPQ2d 1429 state that “A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart...169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart...where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject mater may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.”

III. Since there is no showing over the applied reference, especially with respect to Hashimoto et al, as clearly pointed out and set forth on the record, for this reason alone, the reject on the record is maintained and repeated as followed:

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(A) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1 and 5-16 with respect to the elected species and applied are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al (5,891,608).

Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with an aqueous silver halide color developing solution comprising a color developing agent as elected and a thickening agent as elected and having up to 100 poises. Please see the whole disclosure of the applied reference, especially at the Example 1, TABLE 1, Sample No. 1 and Example 2, TABLE 3, Samples 21 and 27. Since Hashimoto et al disclose, teach, suggest, demonstrate and reduce to practice with the claimed invention using the elected species, the above claims are found to be anticipated by Hashimoto et al.

(B) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 5-16 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al (5,89,608).

The basic for the rejection is essentially the same as that in paragraph "VI. (A)" above with an addition that compounds are not used in the Examples but disclosed, taught and suggested in Hashimoto et al at col.2:34-36 and 46-51, 3:29 to 17:50, 18:7 to 19:42, 22: 66 to

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25:24 are found to be obvious variants and conventional additives in the photographic art as disclosed, taught and suggested by Hashimoto et al. Applicants should show or provide an evidence to the contrary. (1) Applicants are requested and required by law to timely provide a test for a proper examination as clearly pointed out and set forth on the record. (2) It is noted that in the event that applicants do not do a test or sufficient tests as requested and required a properly and timely close examination by law, the claims have and are given no value if the claimed functional language is later shown or found to be inherent in the applied references as clearly pointed out and set forth on the record.

V. Applicant's arguments filed 14 August 2003 have been fully considered but they are not persuasive.

Applicants recognize that Hashimoto et al viscosity value is overlapped as that in the claims.

The language "less than" include zero. The record shows that there is no evidence that such claimed viscosity value is obtained. The claims should be given no value if such viscosity value of zero is not shown to be obtained at the time the application is filed since it is a supposition. It would like to see a test to be carried out at zero and about 0.000 000 001 cp and 0.000 001 and 0.000 1 cp as broadly claimed. In the absence of convincing evidence, (1) the claimed language should and must be read as about 30 dynes/cm to a little less and (2) the arguments have and are given a little to no value since it is only a supposition.

(1) Careful study of the instant application unveils that there is no optimal test being carried out. (2) No optimal language is in the claims. Therefore, any argument with respect to an

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optimum is also a supposition has and given no value. Applicants are again urged to provide a test over the applied reference on the record as clearly pointed out and set forth on the record.

VI. No new reference is further applied in the above rejections. It is proper to made this Office action final.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

VII. Abe (5,998,111) will be next in line to be applied. Applicants are now notified. If it is now applied, applicants may urge that this Office action can not be made final. In a test applicants may considered the teachings and suggestions in this references to speed up the prosecution. Its evidence will be considered.

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VIII. No evidence under Rule 132 will be considered in a second response to this final Office action. Applicants are now notified.

IX. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number of the examiner is 703-746-7172.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
20 August 2003

HOA VAN LE
PRIMARY EXAMINER

Hoa Van Le